

REMARKS

This paper is responsive to an Office Action mailed June 23, 2008. Prior to this response, claims 1-31 were pending. After amending claims 1, 7, 9-11, 13, 16-17, 19-20, 23-24, and 29-30, and canceling claims 6 and 22, claims 1-5, 7-21, and 23-31 remain pending.

In Section 1 of the Office Action claims 1-11 and 17-26 have been rejected under 35 U.S.C 102(e) as anticipated by Pentecost et al. ("Pentecost"; US 6,919,967). The Office Action states that Pentecost discloses all the limitations of base claims 1 and 17, citing col. 6, ln. 5, col. 8, ln. 32-36, col. 8, ln. 53-54, and col. 8, ln. 55-64. This rejection is traversed as follows.

Pentecost discloses a Variable Data Publishing (VDP) system that disassembles "static" text/images and variable data from a document, and downloads the static and variable data to a printer as separate entities to speed the printing process (col. 4, ln. 10-14). The analyzing software 26 first analyzes the pages from an application (i.e., a document) and identifies static page aspects and variable pages aspects, converts the static and variable pages to static data and variable data, and automatically identifies a static page layout (col. 6, ln. 31-39). A static page layout is a block of text or graphics that can be used as the background of each page in a multi-page document (col. 4, ln. 19-43). More explicitly, the analyzing software 26 analyzes pages from program 28 (in RAM 22) to identify static and variable aspects, converts the static and variable pages to static page layout objects and variable print data,

and creates a PostScript or PCL data stream that is downloaded to the page printer 18 (col. 7, ln. 37-57).

Claims 1 and 17 have been amended to recite that a document is processed in the copier pipeline of an MFP to create a document first image, and that a print pipeline processes a text overlay file to create an overlay second image. In short, the claimed invention can be distinguished from Pentecost, because Pentecost does not disclose the use of a copier pipeline, or the merger of an image from the copier pipeline with an image from the print pipeline.

The claimed invention begins with 2 separate and independent elements: a text overlay file and a document. In contrast, Pentecost starts with a single document that is analyzed as having static and variable components. After analysis, Pentecost's document is disassembled into static and variable components, and the static page layout objects and variable print data are sent to the printer in a single data stream with a header that identifies the static page layout and variable page data (col. 7, ln. 50-54). In summary, Pentecost disassembles a document into static and variable data to speed the printing process, but the "merged" hard copy output 38 is simply the original document. The original document has *not* been merged with another document, just disassembled and reassembled.

The Applicant respectfully submits that Pentecost does not disclose a document merger process. Rather, Pentecost discloses a process that disassembles a document into parts, and merges (reassembles) the parts at the print engine. Even if Pentecost's static page is considered a document and its reassembly with the variable data is considered a merger, Pentecost does not disclose the limitation of accepting a separate

overlay text file. Thus, Pentecost does not merge independent files. Again, Pentecost cannot realize this limitation because his static and variable pages are derived from the same common source.

To further clarify that the Applicant's resource file and document are separate entities, claims 1 and 17 have been amended to include the subject matter of separate copier and print pipelines to process separate document in preparation for merger into a single document. This subject matter was originally recited in claims 6 and 22, now canceled. As noted above, Pentecost's analysis software identifies static and variable data in a document that is reassembled before printing. Pentecost does not disclose either the means not the desirability of a user changing the way in which his static and variable pages are reassembled.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Pentecost does not disclose the limitations of separate copier and print pipelines. Pentecost does not disclose the processing of independent files in the copier and print pipelines. Thus, Pentecost does not merge files that are derived from 2 separate and independent sources. Since Pentecost does not explicitly disclose every limitation of claims 1 and 17, he cannot anticipate those claims. Claims 2-5 and 7-11, dependent from claim 1, and claims 18-21 and 23-26, dependent from claim 17, enjoy the same distinctions, and the Applicant respect fully requests that the rejection be removed.

In Section 23 of the Office Action, claims 12, 15, 27, and 30 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Pentecost in view of Tanaka (US 5,959,743). The Office Action acknowledges that Pentecost does not teach message characteristics selection commands, but that Tanaka discloses this feature, and that it would have been obvious to combine the references to add a UI to an MFP. The motivation being for an operator to “set parameters”. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, the *KSR International Co. v Teleflex Inc.* decision (82 USPQ2d 1385, 1395-1397, 2007) suggests 7 exemplary rationales to support a conclusion of obviousness, which include:

A) Combining prior art elements according to known methods to yield predictable results;

B) Simple substitution of one known element for another to obtain predictable results;

C) Use of known technique to improve similar devices (methods, or products) in the same way;

D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

G) Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

The Office Action states that modifications to Pentecost would have been obvious to one of ordinary skill in the art in light of Tanaka. This rejection appears to be most closely grounded in the G) rationale - Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

With respect to this rationale, MPEP 2143 (G) states that the rejection must articulate the following criteria to resolve the *Graham* factual analysis:

(1) a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings;

(2) a finding that there was a reasonable expectation of success; and

(3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

With respect to the above-referenced first factual analysis criteria, the Tanaka reference has been combined with Pentecost based upon the assumption that Pentecost discloses every limitation recited in Applicant's claims 1 and 17. However, as noted above, Pentecost does not

disclose separate copier and print pipelines, the processing of independent files via the two pipelines, and the merger of independent files. Tanaka does not address this subject either. Therefore, even if Tanaka's UI is combined with Pentecost, the combination does not explicitly disclose every limitation of claims 1 and 17. Claims 12 and 15, dependent from claim 1, and claims 27 and 30, dependent from claim 17, enjoy the same advantages.

The Office Action states that it would have been obvious to apply the features of Tanaka to Pentecost in order for an operator to set parameters. However, the setting of parameters suggests neither the means nor desirability of modifying Pentecost in such a manner as to use separate copier and print pipelines in the merger of independent files.

Alternately, the obviousness rejection may be based upon what was well known at the time of the invention. However, to support such as an analysis, evidence must be provided that such a modification would have been obvious to one with skill in the art based upon what was well known at the time of the invention. "(A)nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the art then additional evidence should have been provided. Notable, when the source or motivation is not from the prior art references, "the evidence" of motive will likely consist of an

explanation or a well-known principle or problem-solving strategy to be applied”. *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649.

The only principle or problem-solving strategy mentioned in the Office Action is to “set parameters”. The Office Action does not supply evidence that it was well known at the time of the invention to use copier and print pipelines in the merger of independent files into a combined image.

A *prima facie* analysis of motivation is especially critical in the present circumstances since the rejection is predicated on limitations that are not explicitly disclosed in the prior art references. The claimed invention can only be obvious if an artisan makes substantial modifications to the Pentecost. However, there is nothing in the Tanaka reference that suggests a modification. Further, no evidence has been provided that such a modification would have been obvious based upon well known principles.

With respect to the second analysis criteria needed to support the G) obviousness rationale, even if a practitioner were given the Pentecost and Tanaka references as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention. That is, there can be no reasonable expectation of success if the references, and what was known by artisan at the time of the invention, do not teach all the limitations of the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of Pentecost and Tanaka does not explicitly disclose every limitation of claim

1. Neither has a case been supported that Pentecost can be modified to supply the missing limitations in view of Tanaka, or what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 12, 15, 27, and 30 be removed.

In Section 26 of the Office Action, claim 13 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Pentecost, in view of Miura et al. ("Miura"; US 7,126,704), and further in view of Al-Hussein (US 5,809,167). The Office Action acknowledges that Pentecost does not teach position commands, but that Miura discloses this feature, and that it would have been obvious to combine references for the purpose of previewing user actions. The Office Action states that Al-Hussein discloses a display, and that it would have been obvious to combine references to provide a "personal image computer system together with a general purpose computer system. This rejection is traversed as follows.

The Miura and Al-Hussein references have been combined with Pentecost predicated upon the assumption that Pentecost discloses all the limitations of independent claims 1 and 17. However, as noted above Pentecost does not disclose separate copier and print pipelines, the processing of independent files via the two pipelines, and the merger of independent files. Miura and Al-Hussein also fail to teach these limitations. Therefore, even if Miura and Al-Hussein are combined with Pentecost, the combination still fails to disclose the above-mentioned limitations. Claim 13, dependent from claim 1, enjoys the same advantages.

The Office Action states it would have been obvious to combine references for the purposes of previewing user actions, and

combining a personal image computer with a general purpose computer. However, this statement does not explain how a practitioner in the art could have modified the references to yield all the claimed invention limitations. As explained above, even when combined, Pentecost, Miura, and Al-Hussein fail to disclose all of the claimed invention limitations. The above-quoted statement from Office Action does not explain how even a person with skill in the art could have modified Pentecost's system to independent process files for merger using both a copier and a print pipeline. Alternately stated, the motivation to supply all the limitations missing in the references cannot be inspired by previewing user actions and combine computer functions. Rather, there must be an explicit teaching in the Miura and Al-Hussein references that show a practitioner how Pentecost can be modified to yield the claimed invention. Such a *prima facie* case has not been made.

Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Pentecost that would make all the limitations obvious, the Applicant requests that the rejection of claim 13 be withdrawn.

In Section 27 of the Office Action, claims 14, 16, 29, and 31 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Pentecost, in view of Parnian et al. ("Parnian"; US 6,538,623). The Office Action acknowledges that Pentecost does not teach converting ASCII to PDL, but that Parnian discloses this feature, and that it would have been obvious to combine references for the purpose of adding timestamps. This rejection is traversed as follows.

The Parnian reference has been combined with Pentecost predicated upon the assumption that Pentecost discloses all the limitations of independent claims 1 and 17. However as noted above, Pentecost does not disclose separate copier and print pipelines, the processing of independent files via the two pipelines, and the merger of independent files. Parnian also fails to teach these limitations. Therefore, even if Parnian is combined with Pentecost, the combination still fails to disclose the above-mentioned limitations. Claims 14 and 16, dependent from claim 1, and claims 29 and 31, dependent from claim 17, enjoy the same advantages.

The Office Action states it would have been obvious to combine references for the purposes of adding time stamps. However, this statement does not explain how a practitioner in the art could have modified the references to yield all the claimed invention limitations. As explained above, even when combined, Pentecost and Parnian fail to disclose all of the claimed invention limitations. The above-quoted statement from Office Action does not explain how even a person with skill in the art could have modified Pentecost's system to independent process files for merger using both a copier and a print pipeline. Alternately stated, the motivation to supply all the limitations missing in the references cannot be inspired by the creation of timestamps. Rather, there must be an explicit teaching in Parnian that show a practitioner how Pentecost can be modified to yield the claimed invention. Such a *prima facie* case has not been made.

Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Pentecost

that would make all the limitations obvious, the Applicant requests that the rejection of claim 14, 16, 29, and 31 be withdrawn.

In Section 30 of the Office Action, claim 28 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Pentecost, in view of Tanaka, Miura, and Al-Hussein. The Office Action acknowledges that Pentecost does not teach a UI that supplies prompts for superimposing images, but that Miura discloses this feature, and that it would have been obvious to combine references for the purpose of previewing user actions. The Office Action states that Al-Hussein discloses a display, and that it would have been obvious to combine references to provide a “personal image computer system together with a general purpose computer system. This rejection is traversed as follows.

The Miura, Tanaka, and Al-Hussein references have been combined with Pentecost predicated upon the assumption that Pentecost discloses all the limitations of independent claims 1 and 17. However, as noted above Pentecost does not disclose separate copier and print pipelines, the processing of independent files via the two pipelines, and the merger of independent files. Miura, Tanaka, and Al-Hussein also fail to teach these limitations. Therefore, even if Miura and Al-Hussein and combined with Pentecost, the combination still fails to disclose the above-mentioned limitations. Claim 28, dependent from claim 17, enjoys the same advantages.

The Office Action states it would have been obvious to combine references for the purposes of previewing user actions, and combining a personal image computer with a general purpose computer. However, this statement does not explain how a practitioner in the art

could have modified the references to yield all the claimed invention limitations. As explained above, even when combined, Pentecost, Miura, Tanaka, and Al-Hussein fail to disclose all of the claimed invention limitations. The above-quoted statement from Office Action does not explain how even a person with skill in the art could have modified Pentecost's system to independent process files for merger using both a copier and a print pipeline. Alternately stated, the motivation to supply all the limitations missing in the references cannot be inspired by previewing user actions and combine computer functions. Rather, there must be an explicit teaching in the Miura, Tanaka, and Al-Hussein references that show a practitioner how Pentecost can be modified to yield the claimed invention. Such a *prima facie* case has not been made.

Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Pentecost that would make all the limitations obvious, the Applicant requests that the rejection of claim 28 be withdrawn.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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